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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,107	12/31/1999	CHRISTOPHER L. HAMLIN	K35A0576	8721

26332 7590 06/01/2004

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EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 06/01/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary

Application No.

09/477,107

Applicant(s)

HAMLIN, CHRISTOPHER L.

Examiner

Beemnet W Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3-8 and 10-14 are rejected under 35 U.S.C 103(a) as being unpatentable over Brown et al. (US Patent No. 5,892,826) in view of Lewis (US Patent No. 5,734,819).
3. The rejection is being applied for the same reason as set forth in the previous Office action, pages 2-5, mailed 04/01/04.
4. Claims 2 and 9 are rejected under 35 U.S.C 103(a) as being unpatentable over Brown et al. in view of Lewis and further in view of Le Rue (US Patent No. 5,694,469).
5. The rejection is being applied for the same reason as set forth in the previous Office action, pages 5-6, mailed 04/01/04.

Response to Arguments

6. Applicant's arguments filed 4/28/04 have been fully considered but they are not persuasive.

7. The applicants assert that the examiner rejected claims 1, 10-15, 17, 26-31 under 35 USC 103(a) as unpatentable over Brown et al (5,892,826) in view of Lewis (5,734,819).

The rejected claim numbers are incorrect. The examiner rejected claims 1, 3-8 and 10-14 under 35 U.S.C 103(a) as being unpatentable over Brown et al. (US Patent No. 5,892,826) in view of Lewis (US Patent No. 5,734,819).

8. With respect to claim 1, the applicant argues that combining Brown with Lewis will not teach all of the claim limitations. The applicant further argues that the examiner concedes that Brown does not teach to authenticate a device providing plaintext data before enabling an encryption circuit. Further, Lewis does not disclose or suggest authenticating a device providing plaintext data to an encryption circuit. The examiner respectfully disagrees.

Applicant cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. (In re Keller, 208 USPq 871 (CCPA 1981)). Brown teaches an expanded mode of operation (i.e. address space divided in internal and external memory portions), partitioning the address space to allow certain input/output peripherals or memory devices to be accessed with clear text [See Brown, column 2, lines 30-42], implementing encryption based on the address at which the data is located (i.e. indirectly verifying whether a device is internal or external device) [See Brown, column 4, lines 16-17], and generating an address signal corresponding to different combinations of the address space and selectively performing encryption based on the signal [See Brown, column 3, lines 15-28]. Further, Lewis teaches method of authenticating a device using unique chip identifier [See Lewis, column 2, lines 21-34], which is the method of authentication disclosed in the applicants specification. Therefore, modification of the method of authentication taught by Lewis into the

method of indirect device verification for selective encryption taught by Brown teaches authenticating a device providing plaintext data to an encryption circuit.

The applicant further argues that there is no motivation taught by the relied upon prior art to make the modification and further, the motivation to improve security as suggested by the examiner comes only from applicant's own disclosure which cannot be used as prior art against the claims. The examiner respectfully disagrees.

It is not necessary that the references actually suggest expressly or in so many words the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. (In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); in re Young 159 USPQ 725 (CCPA 1968)). Brown suggests a motivation to secure against cryptanalysis attacks [see Brown, column 1, lines 36-58], by indirect method of device verification based on address location and flexible encryption as specified above. Furthermore, Lewis teaches motivation to implement device authentication using unique device identification to prevent data from executing on unlicensed computer [See Lewis, column 1, lines 14-31].

9. With respect to claims 2 and 9, the applicant argues that Le Rue does not disclose or suggest to authenticate a device providing plaintext data to an encryption circuit, or to authenticate the device receiving the encrypted data. The examiner respectfully disagrees.

Applicant cannot show non-obviousness by attacking references individually where, as here the rejections are based on combination of references. (In re Keller, 208 USPq 871 (CCPA 1981)). The combination of Brown in view of Lewis teaches to authenticate a device providing

plaintext data to an encryption circuit as specified above. Le Rue teaches, at column 4, lines 37-48, a method of verifying the source and destination devices before allowing process to continue. The modification of Le Rue within the combination of Brown and Lewis teaches device authentication of both the source device providing plaintext data to an encryption circuit and destination devices receiving the data.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (703) 305-8895. The examiner can normally be reached on Monday - Friday (8:30 am - 6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

May 26, 2004



KIM YU
PATENT EXAMINER
TECHNICAL STAFF